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10/581,774	03/14/2007	Antonio Augusto Da Silva Rodrigues	SC3	8554
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MIDDLETON & REUTLINGER			EXAMINER	
2500 BROWN & WILLIAMSON TOWER			WU, VICKI H	
LOUISVILLE, KY 40202				
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			02/22/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/581,774

**Applicant(s)**

RODRIGUES ET AL.

**Examiner**

VICKI WU

**Art Unit**

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4-36 and 38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-36 and 38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/003)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This is a final Office action in response to applicant's arguments filed on 10/22/2009, the response to a non-final Office action on 08/17/2009, the claims submitted on 06/06/2006.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 17, 18, 22, 25, 29, 30, 31, 32, 33, 34, 35 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 0128368 A1 (Grzonka).

Regarding claim 1, Grzonka teaches a smoking article comprising a rod of smokable material wrapped in a wrapper, and having a first end suitable only to be lit in use and an opposite second end suitable only for placement in a smoker's mouth in use, said rod comprising at least two discrete smokable segments joined in substantially end-to-end abutment (2 and 3, Figure 1; Detailed Description: pg. 1 paragraph 10), the segment adjacent said second end comprising an encapsulated flavourant incorporated

within the smokable material thereof, and the segment having said first end being devoid of any encapsulated flavourant in the smoking material thereof (Detailed Description: pg. 2 paragraph 7).

Regarding claim 17, Grzonka teaches that said smoking article comprises a filter element adjacent said second end (1, 2, Figure 1; Abstract).

Regarding claims 18, 22, Grzonka teaches a smoking article comprising a flavourant (Detailed Description: pg. 2 paragraph 7) comprising two discrete segments (1 and 2; Figure 1) wherein each said discrete segment is individually circumscribed by a wrapper (9, Figure 4), and said filter element is joined to said segment adjacent said second end of the smoking article by a wrapper (Figure 2).

Regarding claims 25, 29-35, Grzonka teaches a method of making a smoking article comprising incorporating an encapsulated flavourant within a component of a smokable material (Detailed Description: pg. 2 paragraph 7; 1, 2, Figure 1) and forming the smokable material into a first segment (2; Figure 1), and joining the segment in substantially end-to-end abutment with a second segment to form a rod of smokable material (2, 3; Figure 1).

Grzonka further teaches the smoking article comprising two discrete filter segments (1 and 2; Figure 1) wherein the two discrete segments are individually circumscribed by a

wrapper (9, Figure 4), the rod of smokable material is joined to a filter element with a wrapper (Figure 2), the first segment is joined to the second segment with a wrapper (Figure 2), the second segment is joined to the first segment with a wrapper that circumscribes entirely the filter element and the first segment (Figure 2), and the second segment is joined to the first segment by a wrapper that only partially circumscribes each of the first and second segments (8; Figure 1); furthermore, Grzonka teaches the outmost wrapper indicates to the consumer the point at which the taste and aroma characteristics of the smoking article will be modified when being smoked (Detailed Description: pg. 2 paragraph 8), and may be colored (Detailed Description: pg. 3 paragraph 3).

Claims 1, 2, 4, 5, 6, 17 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 6,475,288 (Oliver).

Regarding claim 1, Oliver teaches a smoking article comprising a rod of smokable material wrapped in a wrapper, and having a first end suitable only to be lit in use and an opposite second end suitable only for placement in a smoker's mouth in use, said rod comprising at least two discrete smokable segments joined in substantially end-to-end abutment (50 and 52; Figure 6), the segment adjacent said second end comprising an encapsulated flavourant incorporated within the smokable material thereof, and the segment having said first end being devoid of any encapsulated flavourant in the smoking material thereof (2, Figure 6; col. 7 lines 60-65).

Regarding claim 2, Oliver teaches that the rod of smokable material comprises only two segments (Figure 6).

Regarding claim 4, Oliver teaches that said segment adjacent said second end is the only segment of said smoking article containing encapsulated flavourant therein (2, Figure 6; col. 7 lines 64-65).

Regarding claim 5, Oliver teaches that the flavourant is menthol (col. 7 lines 64-65).

Regarding claim 6, Oliver teaches that the flavourant is encapsulated within alginate, a polysaccharide (col. 7 lines 64-65; col. 8 Claim 1).

Regarding claim 17, Oliver teaches that said smoking article comprises a filter element adjacent said second end (52; Figure 6).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 19, 20, 21, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,475,288 (Oliver) WO 0128368 A1 (Grzonka).

Regarding claims 19, 20, 21, 22, the teachings of the limitations of Oliver are detailed above in the rejection of Claim 2. Oliver does not expressly disclose the two discrete segments are joined by a wrapper, or that the wrapper contains indicia which indicates to the consumer the point at which the taste and aroma characteristics of said smoking article will be modified when being smoked, or that said wrapper is colored, or that said filter element is joined to said segment adjacent said second end of the smoking article by a wrapper.

Grzonka teaches a smoking article wherein two discrete segments are joined entirely by a wrapper (Figure 2); furthermore, the outmost wrapper indicates to the consumer the point at which the taste and aroma characteristics of the smoking article will be modified when being smoked (Detailed Description: pg. 2 paragraph 8), may be colored (Detailed

Description: pg. 3 paragraph 3), and joins the filter element to a segment adjacent said second end of the smoking article (Figure 2).

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to incorporate the wrapper configurations of Grzonka to modify the smoking article of Oliver. The rationale to do so would have been the motivation provided by the teaching of the advantages to using said the wrapper configurations of Grzonka; that in using said the wrapper configurations, in any event wherein the wrapper of the resulting smoking article is torn by accident, said wrapper will be cleanly severed and not produce any undesirable frayed portions (Grzonka: Detailed Description: pg. 1 paragraph 10).

Claims 7, 8, 9, 10, 11, 12, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 0128368 A1 (Grzonka) in view of US Patent Application Publication 2005/0039767 A1 (Mua).

Regarding claims 7-13, the limitations of Grzonka are detailed above in the rejection of Claim 1 under 35 U.S.C. 102(b). Grzonka does not expressly disclose that an inert material, a carbonate, present on the encapsulated flavourant to reduce particulate matter delivered to the consumer during smoke of said smoking article, or that said smokable material comprises reconstituted tobacco material, or that said encapsulated material is incorporated within said reconstituted tobacco material of said segment



adjacent said second end, or that said reconstituted tobacco material constitutes tobacco dust and 20-50% of the smokable material of a segment, and specifically the tobacco dust comprising 30-70% of said reconstituted tobacco material, or that said smokable material is an extruded rod.

Mua teaches a smoking article whose smokable material is comprised of reconstituted tobacco material, in which an inert material, a carbonate, is incorporated into a slurry of reconstituted tobacco material along with a flavourant, menthol, to be encapsulated together within the resulting smoking article so that said carbonate is intrinsically present on the encapsulated flavourant (pg. 7 paragraph 0052); the resulting smoking article comprises 30% reconstituted tobacco material (pg. 7 paragraph 0053) and more specifically 30-70% tobacco dust (pg. 8 paragraph 0061), said reconstituted tobacco material constituting an extruded rod (pg. 10 paragraph 0079).

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to incorporate the specific smokable material of Mua to modify the smoking article of Grzonka. The rationale to do so would have been the motivation provided by the teaching of the advantages to using the specific smokable material of Mua; that in using said specific smokable material to make the smoking article, the resulting smoking articles maintain their flavor in open packs for significant periods of time, up to 1 month; in sealed packs, they maintain their flavor for at least 4 months (Mua: pg. 7 paragraph 0052).

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 0128368 A1 (Grzonka) in view of US Patent 4,785,833 (Holzner).

Regarding claim 14, the limitations of Grzonka are detailed above in the rejection of Claim 1 under 35 U.S.C. 102(b). Grzonka does not expressly disclose that the flavourant is included in an amount of 200 to 50,000 parts per million (ppm).

Holzner teaches a process for flavoring tobacco that comprises generally using about 200 ppm of flavourant, including menthol, to flavor tobacco (col. 4 lines 1-16; col. 6 Example 7).

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to incorporate the amount of flavourant of Holzner to modify the smoking article of Grzonka. The rationale to do so would have been the motivation provided by the teaching of the advantages of using the amount of flavourant discussed in Holzner; that in using said amount, the flavor quality and effect of the flavored tobacco would generally be very satisfactory to most consumers (Holzner: col. 4 lines 13-16).

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 0128368 A1 (Grzonka) in view of US Patent 4,595,024 (Greene).

Regarding claims 15 and 16, the limitations of Grzonka are detailed above in the rejection of Claim 1 under 35 U.S.C. 102(b). Grzonka does not expressly disclose that the length of each discrete segment of the smoking article is 10-90% of the total length of the rod of smokable material, or that the length of each discrete segment is 40-60% of the total length of the rod of smokable material.

Greene teaches a cigarette comprising a tobacco rod of two discrete segments (Abstract) in which each discrete segment of the smoking article is 50% of the total length of the rod of smokable material (col. 4 lines 49-52).

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to incorporate the discrete tobacco-rod segment lengths of Greene to modify the smoking article of Grzonka. The rationale to do so would have been the motivation provided by the teaching of the advantages of incorporating the specific lengths of the tobacco-rod segments of Greene; that incorporating said lengths of the tobacco-rod segments helps the resulting smoking article to reach its maximum utilization in providing more desirable puff-by-puff nicotine delivery that involves a larger amount of nicotine in the first few puffs of the cigarette than in the last few puffs, as well as desirably essentially uniform nicotine delivery during the middle to last puffs (Greene: col. 2 lines 20-29).

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 0128368 A1 (Grzonka) in view of US Patent 4,587,982 (Adams).

Regarding Claim 23, the teachings of the limitations of Grzonka are detailed in the rejection of claim 22 under 35 U.S.C. 102(b) above. However, Grzonka does not expressly disclose that said wrapper is a conventional cigarette wrapper, a tipping wrapper, a pretipping wrapper or a plugwrap.

Adams teaches a smoking article which is wrapped in a ventilated tipping wrapper (Abstract).

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to incorporate the specific tipping wrapper of Adams to modify the smoking article of Grzonka. The rationale to do so would have been the motivation provided by the teaching of the advantages of using the specific tipping wrapper of Adams; that said tipping wrapper is ventilated to provide a desired flow of ventilating air to the smoker's mouth (Adams: col. 1 lines 6-10); additionally, said specific tipping wrapper may be produced easily and economically (Adams: col. 5 lines 1-3) due to the means of printing specific patterns on said specific tipping paper (Adams: col. 6 Claim 9).

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 0128368 A1 (Grzonka) in view of US Patent 5,137,036 (Southwick).

Regarding claim 24, the teachings of the limitations of Grzonka are detailed above in the rejection of claim 1 under 35 U.S.C. 102(b). However, Grzonka does not expressly disclose that an adhesive used to secure the wrapper comprises an encapsulated flavourant therein.

Southwick teaches a smoking article comprising an adhesive used to secure the wrapper that comprises an encapsulated flavourant therein (col. 8 Claim 14).

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to incorporate the specific adhesive of Southwick to modify the smoking article of Grzonka. The rationale to do so would have been the motivation provided by the teaching of the advantages of using the specific adhesive of Southwick; that said specific adhesive provides a flavorant-release component which is characterized by a lack of mobility and / or volatility at ambient temperature, and under normal smoking conditions imparts improved aroma to sidestream smoke (Southwick: col. 2 lines 1-10).

Claims 26, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 0128368 A1 (Grzonka) in view of US Patent Application Publication 2005/0039767 A1 (Mua).

Regarding claims 26 and 27, the teachings of the limitations of Grzonka are detailed above under the rejection of Claim 25 under 35 U.S.C. 102(b). Grzonka does not expressly disclose that the encapsulated flavourant is incorporated within a reconstituted tobacco material, wherein the reconstituted tobacco material is produced by an extrusion process.

Mua teaches a smoking article whose smokable material is comprised of reconstituted tobacco material, in which a flavourant, menthol, is encapsulated within the smoking article (pg. 7 paragraph 0052), said reconstituted tobacco material also have been extruded (pg. 10 paragraph 0079).

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to incorporate the specific smokable material of Mua to modify the smoking article of Grzonka. The rationale to do so would have been the motivation provided by the teaching of the advantages to using the specific smokable material of Mua; that in using said specific smokable material to make the smoking article, the resulting smoking article maintain their flavor in open packs for significant periods of time, up to 1 month; in sealed packs, they maintain their flavor for at least 4 months (Mua: pg. 7 paragraph 0052).

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 0128368 A1 (Grzonka) in view of US Patent 6,475,288 (Oliver).

Regarding Claim 28, the teachings of the limitations of Grzonka are detailed above under the rejection of Claims 25 under 35 U.S.C. 102(b). Grzonka does not expressly disclose that the encapsulated flavourant is encapsulated in a polysaccharide, a starch, a cyclodextrin or an adsorbent.

Oliver teaches a smoking article comprising a rod of smokable material wrapped in a wrapper, the rod comprising two discrete segments in substantially end-to-end abutment (50 and 52; Figure 6), one of the segments comprising an encapsulated flavourant incorporated within a component of the smokable material (2, Figure 6; col. 7 lines 60-65), said encapsulated flavourant being encapsulated within alginate, a polysaccharide (col. 7 lines 64-65; col. 8 Claim 1).

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to incorporate the specific flavourant-encapsulating material of Oliver to modify the smoking article of Grzonka. The rationale to do so would have been the motivation provided by the teaching of the advantages of using said specific flavourant-encapsulating material of Oliver; that in using said specific flavourant-encapsulating material, the migration of significant amounts of the encapsulated flavourants from the filament (which results in losses of such agents) is decreased, and said material also helps prevent the volatilization of said flavourants at ambient temperatures (Oliver: col. 1 lines 20-27; col. 3 lines 62-65).

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 0128368 A1 (Grzonka) in view of US Patent 5,137,036 (Southwick).

Regarding Claim 36, the teachings of the limitations of Grzonka are detailed above under the rejection of Claim 25 under 35 U.S.C. 102(b). Grzonka does not expressly disclose an encapsulated flavourant mixed with an adhesive, the adhesive being applied to the wrapper to secure the wrapper in position.

Southwick teaches a smoking article comprising an adhesive used to secure the wrapper that comprises an encapsulated flavourant mixed therein (col. 8 Claim 14).

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to incorporate the specific adhesive of Southwick to modify the smoking article of Grzonka. The rationale to do so would have been the motivation provided by the teaching of the advantages of using the specific adhesive of Southwick; that said specific adhesive provides a flavorant-release component which is characterized by a lack of mobility and / or volatility at ambient temperature, and under normal smoking conditions imparts improved aroma to sidestream smoke (Southwick: col. 2 lines 1-10).

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,475,288 (Oliver) in view of US Patent 4,526, 183 (Nichols).



Regarding claim 38, Oliver teaches said encapsulated flavourant is structured to be released during use only as the burning material from said first end comes into contact with said encapsulated flavourant (col. 3 lines 62-65; col. 4 lines 26-44). Oliver does not expressly disclose that said burning material comprises coal.

Nichols teaches a filter cigarette comprising a tobacco rod (col. 1 lines 48-52), wherein said rod comprises burning coal when lit (col. 2 lines 66-68; col. 3 lines 1-4).

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to incorporate the specific rod material of Nichols to modify the smoking article of Oliver. It is commonly known in the art to manufacture conventional cigarettes with tobacco rods that comprise coal (Nichols: col. 3 lines 17-19).

### ***Response to Arguments***

Applicant's arguments, see pg. 8, filed 10/22/2009, with respect to the objections to the Specification, have been fully considered and are persuasive. The objections to the Specification have been withdrawn.

In response to Applicant's arguments that the WO 0128368 A1 (Grzonka) device does not have one predetermined lit or mouth end, the final smoking article comprises a

single filter, as one filter has been severed such that only one other filter is left attached to said article. Thus, the user may determine / design in advance (prior to using said article) the specific filter to be either smoked or lit. Thus, Grzonka does teach a device with one predetermined lit or mouth end.

In response to Applicant's arguments that the Grzonka cigarette does not have a rod of smokable material comprising at least two discrete segments joined in end-to-end abutment, both the tobacco rod as well as the filter segment of the Grzonka cigarette comprise smokable material (2 and 3, Figure 1; Detailed Description: pg. 1 paragraph 10). Thus, the Grzonka cigarette does have a rod of smokable material comprising at least two discrete segments joined in end-to-end abutment.

In response to Applicant's arguments that the Grzonka cigarette does not provide the smoker with two distinct flavor sensorial characteristics, these limitations are absent in the Claims of the current application.

In response to Applicant's arguments that the Grzonka cigarette does not disclose the use of encapsulated flavourant in one discrete segment of a tobacco rod, the Grzonka cigarette comprises a rod comprising a smokable segment (the filter segment) that has flavourant (Detailed Description: pg. 3 paragraph 7).

In response to Applicant's arguments that US Patent 6,475,288 (Oliver) does not have a rod of smokable material comprising at least two discrete smokable segments joined in end-to-end abutment, both the tobacco rod as well as the filter segment of the Oliver cigarette comprise smokable material (col. 4 lines 26-44; col. 7 lines 60-65).

Oliver also teaches one discrete smokable segment adjacent the mouth end of its cigarette incorporating an encapsulated flavourant (the tobacco rod), with the other discrete segment adjacent the lit end of the cigarette being devoid of any encapsulated flavour (the filter) (50 and 52; Figure 6; col. 7 lines 60-65).

In response to Applicant's arguments regarding the rejection of claims 7, 8, 9, 10, 11, 12, and 13 under 35 U.S.C. 103(a) over Grzonka in view of US Patent Application Publication 2007/0039767 A1 (Mua), the carbonate of Mua is incorporated into a slurry of reconstituted tobacco material along with a flavourant, menthol, to be encapsulated together within the resulting smoking article so that said carbonate is intrinsically present on the encapsulated flavourant (pg. 7 paragraph 0052).

Further, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that US Patent 4,785,833 (Holzner) does not remedy the defects of Grzonka, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that US Patent 4,595,024 (Greene) does not remedy the defects of Grzonka, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that US Patent 4,587,982 (Adams) does not remedy the defects of Grzonka, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references

would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that US Patent 5,137,036 (Southwick) does not remedy the defects of Grzonka, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that Oliver does not remedy the defects of Grzonka, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICKI WU whose telephone number is (571)270-7666. The examiner can normally be reached on M-F (8:30 am-6:30 pm), every other Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Del Sole can be reached on 571-272-1130. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*N.W./*  
Patent Examiner, TC 1791

*/Joseph S. Del Sole/*  
Supervisory Patent Examiner, Art Unit 1791